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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/507,297 | 02/14/2005 | Thomas Richter | 3197-101 | 4904 |

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EXAMINER

ROGERS, DAVID A

ART UNIT PAPER NUMBER

2856

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 10/507,297 | Applicant(s) RICHTER ET AL. | |
| | Examiner David A. Rogers | Art Unit 2856 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6-20, and 23-41 is/are allowed.
- 6) ☐ Claim(s) 5,21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/10/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

The specification utilizes reference item numbers 16 (16a, 16b) to refer to runner pairs and reference item number 19 to refer to individual runners. It is suggested that the specification (including the claims) be amended throughout to replace runner pair 16a and 16b (each consisting of two runners (reference item 19)) to be a first pair of runners (reference item 101 and 102) and a second pair of runners (reference items 103 104). For example, on page 17 (line 35) replace “sequentially arranged pairs of runners 16a, 16b” would be replaced with --a first pair of runners 101, 102 arranged sequentially with a second pair of runners 103, 104--. On page 20 (lines 11-15) it is requested that the language be amended as follows:

The support plates 20 are attached between the first pair of runners 101,102 and also between the second pair of runners 103, 104. The support plates are fitted with sensors 21.

Appropriate correction is required.

Drawings

2. The drawings are objected to for the following:

- a. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters used in figure 1 (a first prior art device) are used in figure 2 (a different prior art device) and figures 3-27 (the applicant's invention).

b. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

c. In figures 10-14, 25, and 26 the cross-section are shown as ovals. These figures should be redone to show a circular cross-section.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. Claims 5, 12, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the

Art Unit: 2856

patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

Claim Objections

4. Claims 1, 2, 31, and 32 are objected to because of the following.

With regard to claims 1 and 2 the claim language is difficult to understand. The following are suggested for claims 1 and 2:

1. Segment (15) of a sensor-supporting element (11) of a scraper-type device, in which the sensor-supporting element (11) is assembled from such segments (15) and forms a hollow body with a cylindrical envelope surface and the scraper-type device can be moved through a pipeline (13) for the purpose of pipeline testing, whereby the sensor-supporting element (11) is fitted with sensors (21) required for the performance of the pipeline testing, characterized in that

the segment (15) comprises at least a first pair of essentially parallel runners (101, 102) and a second pair of essentially parallel runners (103, 104) ~~two pairs of runners (16), which each consist of essentially parallel runners (19),~~ whereby the at least two pairs of runners ~~(16) of the segment (15)~~ are sequentially arranged ~~behind each other (sequentially) against~~ relative to the direction of motion of the scraper-type device;

the first pair of runners (101, 102) are elastically connected to the second pair of runners (103, 104) by means of connecting elements (17);

Art Unit: 2856

~~the runners (19) are oriented in the direction of motion of the scraper-type device, sequentially arranged runners (19) are connected elastically to each other by means of connecting elements,~~

a sensor plate (20) for sensors (21) is arranged between and connected to the runners (19) of at least one of said pairs of runners; and (16) ~~and connected to the runners (19) of the pair of runners (16),~~

~~and the segment (15) is adapted provided~~ such that it can be connected to additional such segments (15) by means of a connecting device connecting the segments (15) so as to form the hollow body with a cylindrical envelope surface.

2. Segment (15) according to claim 1, characterized in that an additional plate (20) for sensors (21) is arranged between and connected to the second of said pairs of runners ~~at least one additional support a plate (20) for sensors (21) of each pair of runners both the second can be attached between one runner (19) of one segment (15) and one runner (19) of a neighboring segment (15).~~

With regard to claims 31 and 32 it is not clear what "level" is relative to. Simple reorientation of the segment 15 will result in "unelevel" plates and runners. Furthermore, each segment shown I figure 3 for example may have unlevel plates.

Allowable Subject Matter

5. Claims 1-4, 6-20, and 23-41 are allowed subject to the objections noted above. Claims 5, 21, and 11 would also be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph set forth above.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art, such as United States Patents 6,450,104 to Grant *et al.*, 6,381,797 to Filippovitch *et al.*, 4,085,510 to Kirschke, 4,249,810 to O'Conner *et al.*, and 5,371,363 to Lilimpakis do not suggest a segment having at least

Art Unit: 2856

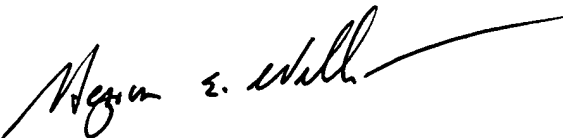
two pairs of essentially parallel runners that are sequentially arranged and elastically connected.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Rogers whose telephone number is (571) 272-2205. The examiner can normally be reached on Monday - Friday (0730 - 1600). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron E. Williams can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dar
03 July 2006


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